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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,053	02/02/2005	Stanley George Bonney	P33090 USW	7571
23347	7590	09/30/2008		
GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B482 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398			EXAMINER JACYNA, J CASIMER	
			ART UNIT 3754	PAPER NUMBER
			NOTIFICATION DATE 09/30/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/523,053	<b>Applicant(s)</b> BONNEY, STANLEY GEORGE	
	<b>Examiner</b> J. Casimer Jacyna	<b>Art Unit</b> 3754	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,7,8,10-29,32-34,36,38 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,10-29,32-34,36,38 and 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/14/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5, 7, 8, 10, 11, 17-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over German DE 100 17 438. As noted in the PCT preliminary examination report dated 9/20/2004 DE/438 discloses a dispenser including a storage chamber 2, an outlet orifice 13, 35, a metering chamber 7, an outlet opening 18, a bleed arrangement 22 and a dispensing mechanism 3, 31 that functions as claimed as explained in the report. In regard to the functional language regarding three positions and two volumetric states, DE has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of DE is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, DE discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

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3. Claims 1, 2, 5, 7, 8, 10, 11, 18-29, 32, 33, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Voellmicke et al. (7,008,433). Voellmicke discloses a dispenser including a storage chamber 3, an outlet orifice 27, a metering chamber 21, an outlet opening at the base of 27, a bleed arrangement 5, 25, and a dispensing mechanism 35, 39 wherein the device can take various positions as shown at A, C, B2 and B3. In regard to the functional language regarding three positions and two volumetric states, Voellmicke has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of Voellmicke is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, Voellmicke discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

4. Claims 1, 2, 5, 7, 8, 10, 11, 18-29, 32, 33, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Spaude et al. (4,077,494). Spaude discloses a dispenser including a storage chamber 2, an outlet orifice 45, a metering chamber 39, an outlet opening 34, a bleed arrangement 42, and a dispensing mechanism 41, 38. The dispenser of Spaude is capable of being used in the manner claimed regardless of whether or not Spaude discloses the actual positions. A user could push piston 40 past opening 42 to isolate a metered dose based on the height of piston 40 above the housing 28 and then dispense as claimed. Whether or not the apparatus is used in this

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manner depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, Spaude discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

5. Claims 1, 2, 5, 7, 8, 10, 11, 18-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Engseth (2,435,647). Engseth discloses a dispenser including a storage chamber 11, an outlet orifice 41, a metering chamber 12, an outlet opening at 42, a bleed arrangement 26, a boundary wall structure as is plunger 13, and an actuation mechanism 45 that is biased by spring 57, 61 into the position shown in figure 1 where the dispenser is in the second configuration that closes the bleed arrangement 26 (see column 4, lines 28-31).

6. Claims 1, 2, 5, 7, 8, 10-15, 18-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (2,497,762). Davis discloses a dispenser including a storage chamber 10, an outlet orifice 24, a metering chamber 16, an outlet opening at 26, a bleed arrangement 22, a boundary wall structure as is plunger 20 that has a low volume position as shown in figure 3 and a large volume position shown in figure 4 and an actuation mechanism 30 wherein the device has a rest position as shown in figure 1 where the dispenser is in the second configuration that closes the bleed arrangement. In regard to claim 34, as disclosed on page 1, lines 42-45, spring 44 biases the dispensing into the figure 1 position.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (2,497,762) in view of German'438. Davis discloses a dispenser including a storage chamber 10 and an outlet valve 26 substantially as claimed but does not disclose the outlet valve to be a flap valve. However, German teaches another plunger type dispenser having an outlet flap valve wherein it would have been obvious to one of ordinary skill in the art at the time the invention was made that the outlet flap valve of German is an art recognized equivalent to the outlet valve 26 of Davis that would work equally well on the Davis device with a high probability of success.

9. Applicant's arguments filed 8/14/2008 have been fully considered but they are not persuasive. In regard to Davis, Applicant broadly contends that Davis is the same as Katz. However, Davis discloses three distinct positions as shown in figures 1, 3 and 4, and changing from the figure 4 to the figure 3 position because the outlet valve is clogged wherein the outlet valve is not opening when moving from the figure 4 to the figure 3 position. Thus Davis is capable of performing the functional limitations as claimed and excess material that cannot exit through outlet valve 26 when moving from the figure 4 to the figure 3 position must necessarily bleed back through 22 into 10 as claimed.

In regard to the other references, Applicant contends that the outlet will allow dispensing when the plunger is moved between positions, however, the claims do not specify that the outlet valve remains closed until claim 12.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 571-272-4889. The examiner can normally be reached on Mon. thru Fri. 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Casimer Jacyna/

Primary Examiner, Art Unit 3754